



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,829	09/24/2003	Mark A. Stansbury	27028-5	5707

7590 12/27/2004

Woodard, Emhardt, Moriarty, McNett & Henry LLP
Bank One Center/Tower
Suite 3700
111 Monument Circle
Indianapolis, IN 46204-5137

EXAMINER

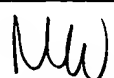
MORRISON, NASCHICA SANDERS

ART UNIT	PAPER NUMBER
----------	--------------

3632

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,829	STANSBURY, MARK A.	
	Examiner	Art Unit	
	Naschica S Morrison	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-12,15,17-22,26-31,34,35 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-12,15,17-22,26-31,34,35 and 40-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the second Office Action for serial number 10/669,829, Furnace Mount and Method of Installation, filed on September 24, 2003. Claims 1, 5-12, 15, 17-22, 26-31, 34, 35, and 40-53 are pending.

Claim Objections

Claim 26 is objected to because of the following informalities: on line 2, "extending" should be --extend--. Appropriate correction is required.

Claim 42 is objected to because of the following informalities: on line 2, insert --is-- after "furnace". Appropriate correction is required.

Claim 44 is objected to because of the following informalities: on line 4, insert --is-- after "furnace". Appropriate correction is required.

Claim 50 is objected to because of the following informalities: on line 1, delete "a" before "molded". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3632

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-12, 15, 17-20, 26-28, 30, 31, 34, 35 and 40-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D465,022 to Stansbury in view of U.S. Patent 4,842,095 to Rozek. Regarding claims 1, 5-12, 26-28, 34, 46, 48, and 49, D465,022 discloses all of the limitations of the claims but does not teach the pad-like component on top of the main body member being adherent and including an adhesive surface. Rozek teaches a mount comprising a main body member (24) and an adherent component (23, 26), wherein the adherent component (23, 26) includes a vibration dampening material (23) having an adhesive layer/outer surface (26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount of Benton by substituting an adhesive layer attached to the upper surface of the adherent component (34), as taught by Rozek, for the coupling means of Benton because one would have been motivated to reduce installation time and further since adhesives, nails, screws, etc. are equivalent for their use in the fastening art and the selection of any of these known equivalents to secure the mount to an object would be within the level of ordinary skill in the art. Regarding claims 15, 17, 18, 20, 40-42, and 45, D465,022 does not teach the mount being substantially rigid; however it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the mount of a rigid material because one would have been motivated to provide a strong, unyielding mount to protect the supported

Art Unit: 3632

object from unnecessary movement. Regarding claims 19, 30 and 31, D456,022 does not expressly teach the main body member being at least 2 inches or the first length being greater than or equal to the second length of Stansbury; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first vertical length to be at least 2 inches or to have modified the first and second lengths of Stansbury such that the first length is greater than or equal to the second length since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Regarding claims 35, 43, 44, 47 and 50, D465,022 does not teach the mount being formed of polymeric material; however it would have been obvious to one of ordinary skill in the art at the time the invention was made to have molded the mount of Stansbury of a polymeric material, such as plastic, because one would have been motivated to reduce manufacturing costs and further since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Claims 21, 22, 29, and 51-53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Patent D465,022 to Stansbury in view of Rozek and further in view of U.S. Patent 5,799,590 to Noguchi. D465,022 in view of Rozek discloses the mounting block as applied to claims 1, 5-12, 15, 17-20, 26-28, 30, 31, 34, 35 and 40-50 above, but does not teach the furnace mounts in combination with a furnace. However, Noguchi discloses a combination (Fig. 14) comprising a furnace (218) having outer walls that define four

Art Unit: 3632

corners and a plurality of mounts (226) located at each corner. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have located a mounting block of Stansbury at each corner of the furnace of Noguchi because one would have been motivated to provide a means for supporting a furnace above the floor as inherently taught by Noguchi.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5-12, 15, 17-20, 26-28, 30, 31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,721,275 to Benton et al. (Benton) in view of U.S. Patent 1,887,283 to Brabson and further in view of U.S. Patent 4,842,095 to Rozek. With regards to claims 1, 5-12, 15, 17, 18, 20, 26-28 and 34, Benton discloses a mount comprising: a substantially rigid main body member (18 generally) having a first vertical length, a first surface (at 14) adapted to engage a floor and parallel to and spaced from a second surface (36), and an integral locating portion having a second vertical length and including an upstanding member (16) extending perpendicular to the second surface (36); an adherent component (34) parallel and connected to the second surface (36) and located on the upstanding member (16); wherein the adherent component (34) includes a vibration dampening pad defined by an elastomeric, cork material (col. 2, line 7); and wherein the mount includes a means (42) for engaging and coupling the main body member (18 generally) to an object (12).

Art Unit: 3632

Benton fails to teach the locating portion including two upstanding wall members.

Brabson discloses a mount comprising a main body member (20) having a locating portion comprising two upstanding wall members (21) that are perpendicular to the main body member and each other, wherein the wall members extend substantially along two sides of the main body member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main body member of Benton to include a second upstanding member perpendicular to the first upstanding member (16) because one would have been motivated to provide a means for a means for firmly holding the supported object against movement as taught by Brabson (pg. 2, lines 12-17). Benton also fails to disclose the coupling means being an adhesive surface included with the adherent component (34). Rozek teaches a mount comprising a main body member (24) and an adherent component (23, 26), wherein the adherent component (23, 26) includes a vibration dampening material (23) having an adhesive layer/outer surface (26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount of Benton by substituting an adhesive layer attached to the upper surface of the adherent component (34), as taught by Rozek, for the coupling means of Benton because one would have been motivated to reduce installation time and further since adhesives, nails, screws, etc. are equivalent for their use in the fastening art and the selection of any of these known equivalents to secure the mount to an object would be within the level of ordinary skill in the art.

Art Unit: 3632

Regarding claim 19, Benton does not expressly teach the main body member being capable of supporting a furnace at least 2 inches above a floor. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first vertical length to be at least 2 inches since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Regarding claims 30 and 31, Benton also fails to teach the first vertical length being greater than the second vertical length. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first and second lengths of Benton such that the first length is greater than or equal to the second length since it has been held that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Regarding claim 35, Benton does not teach the mount being formed of a polymeric material; however it would have been obvious to one of ordinary skill in the art at the time the invention was made to have molded the mount of Benton of a polymeric material, such as plastic, because one would have been motivated to reduce manufacturing costs and further since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Claims 21, 22, 29, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,799,590 to Noguchi in view of Benton and further in view of Rozek. Regarding claims 21, 22, and 29, Noguchi discloses a combination (Fig.

Art Unit: 3632

14) comprising a furnace (218) having outer walls that define four corners and a plurality of mounts (226) located at each corner. Noguchi does not teach the mounts abutting outer walls of the furnace. Benton discloses a mount comprising: a substantially rigid, single piece integrally formed main body member (18 generally) having a first surface (at 14) adapted to engage a floor and parallel to and spaced from a second surface (36), and an integral locating portion extending from the second surface (36); an adherent component (34) parallel and connected to the second surface (36) and located on the upstanding member (16); wherein the adherent component (34) includes a vibration dampening pad defined by an elastomeric, cork material (col. 2, line 7); and wherein the mount includes a means (42) for engaging and coupling the main body member (18 generally) to an object (12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of Noguchi by substituting the mounts of Benton for the mounts of Noguchi because one would have been motivated to provide a stable leveling device that is simple, easy to use, and economical in cost to manufacture as taught by Benton (col. 1, lines 29-32). Noguchi in view of Benton does not disclose the coupling means being an adhesive surface included with the adherent component (34). Rozek teaches the mount as applied to claims 1, 5-12, 15, 17-20, 26-28, 30, 31, 34 and 35 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount of Benton by substituting an adhesive layer attached to the upper surface of the adherent component (34), as taught by Rozek, for the coupling means (42) because one would have been motivated to reduce installation time and

Art Unit: 3632

further since adhesives, nails, screws, etc. are equivalent for their use in the fastening art and the selection of any of these known equivalents to secure the mount to an object would be within the level of ordinary skill in the art. Regarding claims 51-53, Benton does not teach the main body member being molded of a polymeric material; however it would have been obvious to one of ordinary skill in the art at the time the invention was made to have molded the mount of Benton of a polymeric material, such as plastic, because one would have been motivated to reduce manufacturing costs and further since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Claims 40-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benton in view of Rozek. With regards to claims 40-50, Benton discloses a mount comprising: a substantially rigid, integrally formed main body member (18 generally) having a first surface (at 14) adapted to engage a floor and parallel to and spaced from a second surface (36), and an integral locating portion including an upstanding member (16) extending perpendicular to the second surface (36); an adherent component (34) parallel and connected to the second surface (36) and located on the upstanding member (16); wherein the adherent component (34) includes a vibration dampening pad defined by an elastomeric, cork material (col. 2, line 7); and wherein the mount includes a means (42) for engaging and coupling the main body member (18 generally) to an object (12). Benton does not teach the coupling means being an adhesive surface included with the adherent component (34). Rozek teaches a mount comprising a main

Art Unit: 3632

body member (24) and an adherent component (23, 26), wherein the adherent component (23, 26) includes a vibration dampening material (23) having an adhesive layer/outer surface (26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount of Benton by substituting an adhesive layer attached to the upper surface of the adherent component (34), as taught by Rozek, for the coupling means of Benton because one would have been motivated to reduce installation time and further since adhesives, nails, screws, etc. are equivalent for their use in the fastening art and the selection of any of these known equivalents to secure the mount to an object would be within the level of ordinary skill in the art. Benton also does not teach the mount being formed of a polymeric material; however it would have been obvious to one of ordinary skill in the art at the time the invention was made to have molded the mount of Benton of a polymeric material, such as plastic, because one would have been motivated to reduce manufacturing costs and further since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Response to Arguments

Applicant's arguments filed 9/30/04 have been fully considered but they are not persuasive. In response to applicant's argument that Benton is believed to teach transferring the load of the furniture through point 32 to the floor in order to enhance the stability for tall narrow pieces of furniture, that Benton further teaches securely fixing the

Art Unit: 3632

furniture to the leveling device (by way of mechanical fasteners) in an effort to further address this concern, and that the utilization of an adhesive fastener "would destroy many of the reasons for Benton", examiner respectfully disagrees. Benton teaches that an object of the invention is to provide a stable base for the tall narrow furniture pieces *when the furniture is used on thick rugs* (col. 1, lines 22-24). Benton further teaches that the point 32 is used to penetrate through carpet, underlayment and dig into flooring underneath to stabilize the base of the furniture (col. 2, lines 3-6). Based on the above teachings, it is not believed that the primary focus or objective of Benton is to transfer vibrations or the load of the furniture through the leveling device and the point 32 in an effort to stabilize the furniture. Benton is concerned with providing a leveler which acts a base for the furniture which can be anchored to the floor especially when the furniture rests of a carpeted surface. Benton in no way teaches or addresses the transfer of vibration from the furniture to the floor supporting structure in order to enhance the stability of the furniture and applicant has not provided any specific recitations within Benton to support this position. Therefore, the substitution of an adhesive fastener for the mechanical fasteners as detailed in the rejections above is not deemed to destroy the function or teachings of the apparatus of Benton.

In response to applicant's statement of not following how one reviewing the teaching of the Brabson references as a whole would be motivated to make the modification suggested in the Office action, the Brabson reference does not merely teach that the anchoring of the four plates 20 will hold the article against the movement specified in lines 12-17 on page 2. It is clear from the paragraph cited (i.e. lines 12-23

Art Unit: 3632

on page 2) that the arrangement of the devices (and their respective locating flanges 21) on the corners of the furniture holds the furniture against movement in any direction. Therefore the Brabson reference as a whole provides the motivation to make the modification suggested in the rejections above.

Applicant's disagreement with the conclusions drawn regarding the declarations of Tim Jacobson, Dave Cournoyer, Ron Jackson, Stephen Hutcherson, John Knipe, Gene Lee, Rick Elston, and Jeff Malone has been considered but is not persuasive. Applicant suggests that the declarations provide many benefits associated with the furnace mounting blocks, such as enhanced installation, ability to slide the furnace on the blocks, etc.; however the declarations themselves do not specifically set forth these benefits.

Applicant's arguments regarding the declaration of Walter Key are not persuasive as they generally reiterate the statements within the declaration itself and do offer any additional support in response to the comments made in the previous Office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3632

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.



Naschica S. Morrison
Patent Examiner
Art Unit 3632
12/16/04



LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER